

Remarks

Entry of the above amendments to the above-identified application is respectfully requested. Such amendments are deemed to place the application in condition for examination and examination is, therefore, respectfully requested.

To highlight the distinction of the above referenced invention over the prior art as interpreted by the Examiner in the Office Action of January 29, 2003, Paper No. 7, the claims were amended as set forth herein. Claims 1, 5, 24, and 25 were amended to more clearly define the subject matter of the invention and to place all of the claims remaining in the application in condition for allowance. In view of the finality of the Office Action, every attempt was made to remove any issues remaining in the application and to place all of the claims in condition for allowance. No new matter was presented and such amendments are deemed unobjectionable. Entry thereof is respectfully requested. It is also respectfully requested that the Examiner reconsider the present application and claims as currently pending in view of the following remarks.

Applicants' gratefully acknowledge the Examiner's approval of the proposed drawing correction filed on November 13, 2002.

Claim 24 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

which Applicants regard as their invention. While Applicants are of the opinion that claim 24 is in fact definite, Applicants have amended the claims to further clarify the invention as suggested by the Examiner.

Applicants assert that no new matter has been added, that the claims particularly point out and distinctly claim the subject matter that Applicant regards as the invention, and that the amended independent claims as well as the claims depending therefrom are allowable. Accordingly, reconsideration and withdrawal of the rejection of claim 24 under 35 U.S.C. § 112 is respectfully requested.

In the Office Action, the Examiner rejected independent Claims 1, 5, 24, and 25 under 35 U.S.C. 102(b) as being anticipated by Kinstler, U.S. Patent 6,406,100. The undersigned attorney respectfully traverses the Examiner's rejection of independent Claims 1, 5, 24, and 25 and dependent Claims 2, 3, 11, 15-19, 21, and 26-28 in view of the amendments presented herein and submitted herewith as well as the following argument.

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. 102 is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents, functioning in substantially the same way to produce substantially the same results. As most recently noted by the Court of Appeals of the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick*, 221 USPQ. 481, 485 (1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. 102, the Court stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

Applicant's amended independent Claims 1, 5, 24, and 25 require, *inter alia*, a trim ring and a cladding, said trim ring and said cladding being in an overlapping relationship in a radial direction.

As shown in Fig. 3, Kinstler does not disclose a trim ring and cladding being in an overlapping relationship in a radial direction as required by Applicants' independent claims. On page 3 of the Office Action, it is mistakenly assumed that the trim ring and cladding of Kinstler always overlap in the radial direction. To the contrary, the trim ring and cladding of Kinstler sometimes overlap and only in the axial direction. Fig. 3 of Kinstler makes clear that the trim ring and cladding are overlapping in an axial direction and have surfaces that merely abut in the radial direction. Abutment does not equate to overlap and, in fact, the invention of Kinstler does not require any overlap at all as evidenced by Fig. 10 thereof.

Kinstler thus fails to disclose each and every element arranged as in independent claims 1, 5, 24, and 25 and, Applicants' independent claims are thereby distinguishable over Kinstler. Therefore, in applying the test for anticipation as set forth in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick, supra*, Kinstler does not anticipate either independent Claim 1, 5, 24, or 25. Accordingly, reconsideration and withdrawal of the rejection of Claims 1, 2, 3, 5, 11, 15-19, 21, and 24-28 under 35 U.S.C. 102(b) is respectfully requested.

The Examiner rejected Claims 22 and 23 under 35 U.S.C. § 103 as being unpatentable over Kinstler. The Examiner also rejected Claim 9 under 35 U.S.C. § 103 as being unpatentable over Kinstler in view of the teachings of Kemmerer et al., U.S. Patent 6,270,167. The Examiner further rejected Claims 4 and 6 under 35 U.S.C. § 103 over Kinstler in view of Tully et al., U.S. Patent 3,517,968. Applicant's attorney respectfully traverses each of the 35 U.S.C. 103 rejections set forth herein in view of the claims as amended and for the reason that Applicant's invention is not an obvious improvement over the cited references.

With respect to the rejections under 35 U.S.C. 103, it is noted in MPEP Section 706 that the standard of patentability to be followed in the examination of a patent application is that which was enunciated by the Supreme Court in *Graham v. John Deere*, 148 USPQ 459 (1966), where the Court stated:

“Under Section 103, the scope and the content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.”

Accordingly, to establish a prima facie case of obviousness, the Patent Office must; (1) set forth the differences in the claim over the applied references; (2) set forth the proposed modification of the references which would be necessary to arrive at the claimed subject matter; and (3) explain why the proposed modifications would be obvious. To satisfy step (3) above, the Patent Office must identify where the prior art

provides a motivating suggestion, inference or implication to make the modifications proposed in step (2) above. *In re Jones*, 21 USPQ2d 1941(Fed. Cir. 1992).

The mere fact that the prior art may be modified by the Examiner does not make the modification obvious unless the prior art suggests the desirability for the modification. *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992). In the present case, the Examiner has failed to make a proper prima facie showing of obviousness since the Examiner has failed to show how the prior art suggests the desirability of the proposed modification.

Kinstler appears to be directed to the problems associated with flow forming a full-face sheet metal wheel cover over a rim flange of a vehicle wheel. Specifically, the rim flange portion of a sheet metal wheel cover tends to spring open due to the memory or elasticity of the metal. This is known as a "springback" condition under which the sheet metal wheel cover becomes unseated from the wheel. This springback condition can allow water, mud, salt, and other debris to enter between the outer end of the wheel cover and the outer peripheral end of the bead seat retaining flange (rim flange) of the wheel and can also cause the outer peripheral edge of the wheel cover to cut into the tire.

To overcome this problem Kinstler et al. propose to divide a full-face wheel cover into two separate elements – a first wheel cover to cover the outboard surface of the wheel and a second wheel cover to cover the entire portion of the outer peripheral end of the outboard tire bead seat retaining flange. Axially extending outer

ends of the first and second wheel covers overlap in an axial direction, underneath an axially extending portion of the bead seat retaining flange of the wheel.

Kemmerer et al. is likewise directed to the same problems of Kinstler. Kemmerer et al. proposes to 1) form at least one annular groove in an inner surface of an outboard tire bead seat retaining flange of a wheel, and 2) to dispose an adhesive/sealant in the at least one annular groove to secure the outer end of the wheel cover to the outer peripheral end of the rim flange to provide a seal therebetween.

Tully et al. is directed to the problems of rattling and rotation of a trim ring with respect to a vehicle wheel and the entry of moisture, dirt, or other foreign matter into the space between the trim ring and wheel rim face.

Tully et al. proposes to provide a trim ring having an inboard edge with a circumferentially extending groove that carries an O-ring to provide a squeeze fit between the inboard edge of the trim ring and an inner surface of the wheel. An outboard edge of the trim ring is mechanically captured within a reentrant radius on the outboard bead flange (rim flange) of the wheel and is further secured thereto by a ring of adhesive therebetween.

Applicants' invention is directed to several problems associated with mounting a wheel cover to a wheel including the difficulty and cost in holding tight radial tolerances across a single wheel cover, from the center of the wheel cover to the radially peripheral edge of the rim flange portion of the wheel cover.

Thus, Applicants' teach use of a multiple-piece wheel covering including a trim ring and a cladding, the trim ring and cladding being in an overlapping relationship in a radial direction so as to take up radial dimensional tolerance variation in the trim ring and cladding across the outboard face of the wheel.

The differences between Applicant's invention and the prior art references cited by the Examiner in the rejection under 35 U.S.C. 103 are quite clear. The solutions taught by each of the references are directed to problems totally different than that described in Applicant's invention. For example, Kinstler and Kemmerer et al. are directed toward springback and sealing problems of a sheet metal wheel cover. In contrast, Applicants' invention is directed to a problem not even recognized in the cited references either singularly or collectively. Not a single applied reference mentions the difficulties and expense of maintaining a tight tolerance across the face of a single wheel cover from a center thereof to a radially outer periphery thereof. Absent a recognition of this problem, it would be impossible for its solution to be obvious to anyone. Thus Applicants' invention is an unobvious improvement over the prior art and not an obvious modification or combination of the cited references.

Furthermore, the Kemmerer et al. and Tully et al. references fail to disclose, teach, or suggest the use of a trim ring that covers a rim flange lip of a wheel. Kemmerer et al. simply fails to teach use of any trim ring at all, while Tully et al. teaches the use of a trim ring but fails to teach that the trim ring radially extends outward enough to cover the rim flange lip of the wheel.

Finally, Kinstler fails to disclose, teach, or suggest the combination of a trim ring and cladding in an overlapping relationship in a radial direction as required by Applicants' claims. In fact, Kinstler teaches the opposite of Applicants and, as stated in the MPEP, if any of the cited references teach away from the suggested combination, or teach away from the claims, or render any of the cited references unsatisfactory for their intended purpose, then the claimed invention is distinguishable over the combination of cited references. (MPEP § 2145)

Specifically, Kinstler teaches overlapping a trim ring and cladding in an axial direction only, which is opposite of Applicants' invention and contrary to the misstatement on page 3 of the Office Action that "it must be assumed that [the trim ring and cladding of Kinstler] always overlap in the radial direction regardless of tolerance variations." This statement is incorrect because the axial overlapping relationship of the trim ring and cladding of Kinstler will not take up or absorb radial tolerance variation in the cladding. In other words, if the cladding diameter is even one millimeter too small, then there will be a one millimeter gap between the radially outer edge of the cladding and the radially inner edge of the trim ring. Thus, Kinstler teaches away from Applicants' invention, is not capable of taking up radial tolerance variation, and does not solve the problem that Applicants' identified. Therefore, Applicants' invention is patentably distinguishable over Kinstler and any combination with the other references.

Applicants' invention is thus an unobvious improvement over the cited references and not an obvious modification or combination of any of the references of

record in this application. When viewed singularly or collectively, none of the cited references discloses, teaches, or even suggests a wheel covering combination including a trim ring and cladding, with the trim ring and cladding being in a overlapping relationship in a radial direction as required by Applicants' independent claims. Thus, Applicants' independent claims are not rendered obvious by any of the cited references and, under principles of claim dependency, none of the dependent claims are rendered obvious either. Therefore, reconsideration and withdrawal of the § 103 rejections is respectfully requested.

The Office Action objected to claims 7, 8, 10, 12, 13, 14, and 20 as being dependent upon a rejected base claim, but indicated that such claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In light of the amendments to independent claims 1, 5, 24, and 25, as well as the arguments set forth above, it is respectfully submitted that Applicants' independent claims are allowable. Accordingly, since dependent claims 7, 8, 10, 12, 13, 14, and 20 are but further delineations of the independent claims from which they depend, the objected to dependent claims, by definition, are also allowable.

Applicants thus respectfully traverse the objection in view of the arguments set forth above for the reason that Applicants' invention is novel and not an obvious improvement over the cited references. Reconsideration and withdrawal of the objections of claims 7, 8, 10, 12, 13, 14, and 20, and formal allowance thereof, is respectfully requested.

In view of the foregoing remarks, the undersigned attorney respectfully submits that the amended independent claims as well as the dependent claims are clearly allowable. Therefore, Applicant's attorney respectfully requests that the Examiner's rejections under 35 U.S.C. §§ 102, 103, and 112 be reconsidered and withdrawn from the claims as amended herein and that a formal Notice of Allowance be issued therefor.

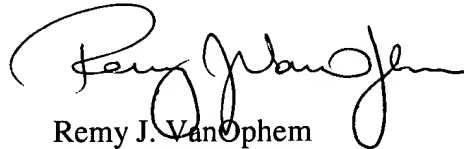
The references made of record but not relied on, namely Thissen et al, Ferriss et al., and Tanghetti has been reviewed with interest. It is respectfully submitted that the present invention defines patentably thereover.

Every attempt has been made to place the claims in condition for allowance and it is respectfully asserted that there are no further issues, formal or substantive, that remain for prosecution. Formal allowance of the application is, therefore, respectfully solicited. If the Examiner is not persuaded that all issues are resolved, the undersigned respectfully requests that the Examiner initiate a telephone interview to enable an attempt to be made to resolve any remaining issues. Otherwise, in the event the Examiner is not persuaded of the patentability of the claims he is respectfully requested to enter the amendment for purposes of appeal.

If the Examiner has any questions with respect to any matter now of record, Applicant's attorney may be reached at (248) 362-1210.

Respectfully submitted,

VANOPHEM & VANOPHEM, P.C.



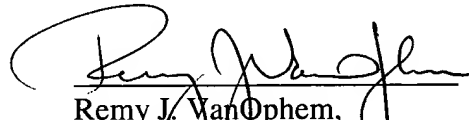
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Date: July 7, 2003



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